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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,955	03/31/2004	Jonathan Lee Orwant	528401-7	5873

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COHEN, PONTANI, LIEBERMAN & PAVANE
551 Fifth Avenue, Suite 1210
New York, NY 10176

EXAMINER

WENDELL, ANDREW

ART UNIT	PAPER NUMBER
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2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/813,955

Applicant(s)

ORWANT ET AL.

Examiner

Andrew Wendell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-25,28-42 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-25,28-42 and 45-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/2007 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 5-6, 9, 11-13, 17, 19-25, 33-42, 47-48, and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Vataja (US Pat Pub# 2002/0123327).

Regarding claim 1, Vataja's location-based message teaches enabling both the sender and the intended recipient to send and receive an electronically deliverable message (Sections 0023 and 0033); obtaining a message provided by the sender (Sections 0027-0028); obtaining a location designated by the sender for delivery of the message (Sections 0004-0006 and 0027); tracking a specified mobile object having a position-determining device that determines its own current position, and which transmits its then current position at preset time intervals (Sections 0029-0030);

determining from the transmitted current position whether the specified mobile object has reached the designated location (Sections 0007 and 0031); and initiating a procedure for automatic delivery of the message electronically to the intended recipient upon the specified mobile object being determined to have reached the designated location (Sections 0008 and 0031).

Regarding claim 2, Vataja teaches wherein the specified mobile object is the intended recipient (Sections 0004-0008 and 0027-0031).

Regarding claim 3, Vataja teaches wherein the specified mobile object is identified by the sender, and is other than the intended recipient (Sections 0004-0008 and 0027-0032).

Regarding claim 5, Vataja teaches wherein the intended recipient is animate (Sections 0004-0008 and 0027-0031 and 0033).

Regarding claim 6, Vataja teaches wherein the sender is a mobile object (Sections 0027-0028).

Regarding claim 9, Vataja teaches wherein the message is at least of text (SMS, Sections 0004-0008 and 0027-0031).

Regarding claim 11, Vataja teaches wherein delivery of the message is controlled in accordance with a delivery rule provided by the sender (Sections 0004-0008 and 0027-0032).

Regarding claim 12, Vataja teaches wherein initiating the procedure for automatic delivery of the message upon detection of the specified mobile object

reaching the designated location message comprises processing the delivery rule (Sections 0004-0008 and 0027-0032).

Regarding claim 13, Vataja teaches wherein the obtaining of the message comprises receiving and storing a message based on input from the sender (Sections 0004-0008 and 0027-0032).

Regarding claim 17, Vataja teaches further comprising obtaining an identification of the intended recipient based on input from the sender (Sections 0004-0008 and 0027-0033).

Regarding claim 19, Vataja teaches wherein the intended recipient includes a plurality of recipients identified by the sender (Section 0051 and 0068).

Regarding claim 20, Vataja teaches providing each of the clients with a position-determining device that determines its own current position (Sections 0027 and 0029); obtaining, at the server, a message based on input from a first client (Sections 0027-0028); obtaining, at the server, a designated location based on input from the first client (Sections 0004-0006 and 0027); obtaining, at the server, an identification of a second client as the intended recipient of the message, based on input from the first client (Sections 0031-0032); obtaining, at the server, identification one of the clients which is to be tracked for delivery of the message (Section 0029 and 0031-0032); determining, from the position-determining device of the client to be tracked for delivery of the message, whether the client being tracked has arrived at the designated location (Sections 0007 and 0031); and automatically triggering electronic delivery of the

message to the intended recipient upon the tracked mobile client being determined to have arrived at the designated location (Sections 0008 and 0031).

Regarding claim 21, Vataja teaches wherein the client to be tracked for delivery of the message is the second client, and wherein the step of obtaining identification of a client to be tracked for delivery of the message comprises deriving the identification from the identification of the second client (Sections 0004-0008 and 0027-0031).

Regarding claim 22, Vataja teaches wherein the step of obtaining identification of a client to be tracked for delivery of the message comprises obtaining the identification based on input from the first client (Sections 0004-0008 and 0027-0031).

Regarding claim 23, Vataja teaches providing each of the clients with a position-determining device that determines its own current position (Sections 0027 and 0029); obtaining, at the server, a message based on input from a first client (Sections 0025-0028); obtaining, at the server a designated location based on input from the first client (Sections 0004-0006 and 0027); obtaining, at the server, a delivery rule based on input from the first client for delivering the message to an intended recipient, wherein the delivery rule includes arrival of a specified client from among the plurality of clients at the designated location (Sections 0004-0006 and 0027-0028); determining, from the position-determining device of the mobile client, whether the specified mobile client has arrived at the designated location (Sections 0007 and 0031); and upon the specified mobile client being determined to have arrived at the designated location, triggering electronic delivery of the message to the intended recipient, based upon the delivery rule (Sections 0008 and 0031).

Regarding claim 24, Vataja teaches further comprising obtaining, at the server, identity of the specified mobile client based on input from the first client (Sections 0004-0008 and 0027-0031).

Regarding claim 25, Vataja teaches further comprising obtaining, at the server, identity of the intended recipient based on input from the first client (Sections 0004-0008 and 0027-0031).

Regarding claim 33, Vataja teaches enabling each of the plurality of users to both send and receive electric message data (Sections 0023 and 0033); processing and storing electronic message data provided by the sender (Sections 0027-0028); tracking the position of the specified mobile object (Sections 0007 and 0031); and automatically delivering the stored message data to the intended recipient upon arrival of the specified mobile object at a designated location (Sections 0008 and 0031).

Regarding claim 34, Vataja teaches wherein the message data includes the message, the intended recipient, and a delivery rule (Sections 0004-0008 and 0027-0031).

Regarding claim 35, Vataja teaches wherein the message data includes the message (Sections 0004-0008 and 0027-0031).

Regarding claim 36, Vataja teaches wherein the message data includes the intended recipient (Sections 0004-0008 and 0027-0031).

Regarding claim 37, Vataja teaches wherein the message data includes a delivery rule (Sections 0004-0008 and 0027-0031).

Regarding claim 38, Vataja teaches wherein the message data includes identity of the specified mobile object (Sections 0004-0008, 0025, and 0027-0032).

Regarding claim 39, Vataja teaches wherein the message data includes the designated location (Sections 0004-0008 and 0027-0031).

Regarding claim 40, Vataja teaches the means for enabling the sender and the intended recipient to both send and receive an electronically deliverable message (Sections 0023 and 0033); means for obtaining a message provided by the sender (Sections 0025-0028); means for obtaining a location designated by the sender for delivery of the message (Sections 0004-0006 and 0027); means for tracking a specified mobile object having a position-determining device that determines its own current position, and which transmits its then current position at preset time intervals (Sections 0007, 0029, and 0031); means for determining from the transmitted current position whether the specified mobile object has reached the designated location (Sections 0007, 0029, and 0031); and means for initiating a procedure for automatic delivery of the message electronically to the intended recipient upon the specified mobile object being determined to have reached the designated location (Sections 0008 and 0031).

Regarding claim 41, Vataja teaches means for obtaining, at the server, a message based on input from a first client (Sections 0025-0028); means for obtaining, at the server, a designated location based on input from the first client (Sections 0004-0006 and 0027); means for obtaining, at the server, an identification of a second client as the intended recipient of the message, based on input from the first client (Sections

0004-0006, 0027-0028, and 0031-0032); means for obtaining, at the server, identification of a mobile client to be tracked for delivery of the message (Sections 0007, 0029, and 0031); means for determining, from the position-determining device of the client to be tracked for delivery of the message, whether the client being tracked has arrived at the designated location (Sections 0007, 0029, and 0031); and means for automatically triggering electronic delivery of the message to the intended recipient upon the tracked mobile client being determined to have arrived at the designated location (Sections 0008 and 0031).

Regarding claim 42, Vataja teaches means for obtaining, at the server, a message based on input from a first client (Sections 0025-0028); means for obtaining, at the server, a designated location based on input from the first client (Sections 0004-0006 and 0027); means for obtaining, at the server, a delivery rule based on input from the first client for delivering the message to an intended recipient, wherein the delivery rule includes arrival of a specified mobile client at the designated location (Sections 0004-0006, 0027-0028, and 0031-0032); means for determining, from the position-determining device of the mobile client, whether the specified mobile client has arrived at the designated location (Sections 0007, 0029, and 0031); and means for upon the specified mobile client being determined to have arrived at the designated location, triggering electronic delivery of the message to the intended recipient, based upon the delivery rule (Sections 0008 and 0031).

Regarding claim 47, Vataja teaches means for enabling the sender and the intended recipient to both send and receive an electronically deliverable message

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(Sections 0023 and 0033); means for processing and storing message data provided by the sender (Sections 0025-0028); means for tracking the position of the specified mobile object (Sections 0007, 0029, and 0031); and means for automatically delivering a message electronically to the intended recipient upon arrival of the specified mobile object at a designated location (Sections 0008 and 0031).

Regarding claim 48, Vataja teaches obtaining a message provided by the sender (Sections 0025-0028); obtaining a location designated by the sender for delivery of the message (Sections 0004-0006 and 0027); tracking a specified mobile object having a position-determining device that determines its own current position, and which transmits its then current position at preset time intervals (Sections 0029-0031); determining from the transmitted current position whether the specified mobile object has reached the designated location (Sections 0007, 0029, and 0031); and initiating a procedure for automatic delivery of the message electronically to the intended recipient upon the specified mobile object being determined to have reached the designated location, wherein the specified mobile object is other than the intended recipient (advertisement message for a pasta place to a person who doesn't like pasta but is in the area location, Sections 0007, 0029, 0031-0032, and 0035-0036).

Regarding claim 50, Vataja teaches obtaining a message provided by the sender (Sections 0025-0028); obtaining a location designated by the sender for delivery of the message (Sections 0004-0006 and 0027); tracking a specified mobile object having a position-determining device that determines its own current position, and which transmits its then current position at preset time intervals (Sections 0029-0031);

determining from the transmitted current position whether the specified mobile object has reached the designated location (Sections 0007, 0029, and 0031); and initiating a procedure for automatic delivery of the message electronically to the intended recipient upon the specified mobile object being determined to have reached the designated location (Sections 0008 and 0031), wherein the message is at least one of data, text, audio and video modes (SMS, picture; Sections 0025, 0027, and 0034).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vataja (US Pat Pub# 2002/0123327) in view of Meunier (US Pat Appl# 2005/0113107).

Regarding claim 4, Vataja's location- based message teaches the limitations in claim 1. Vataja fails to teach an intended recipient is a stationary object.

Meunier's method for determining proximity of devices in a wireless network teaches wherein the intended recipient is a stationary object (Section 0012).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate an intended recipient is a stationary object as taught by Meunier into Vataja's location- based message in order to improve location monitoring (Sections 0005 and 0006).

4. Claims 10 and 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vataja (US Pat Pub# 2002/0123327) in view of Owensby (US Pat# 6,647,257).

Regarding claim 10, Vataja teaches the limitations in claim 1. Vataja fails to teach wherein a mode in which the message is reproduced for the intended recipient is in accordance with a setting controlled by the intended recipient.

Owensby's method for providing targeted messages based on wireless mobile location teaches a mode in which the message is reproduced for the intended recipient is in accordance with a setting controlled by the intended recipient (Col. 9 line 50-Col. 10 line 11).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a mode in which the message is reproduced for the intended recipient is in accordance with a setting controlled by the intended recipient as taught by Owensby into Vataja's location-based message in order to subsidize the cost and offer interactivity (Col. 10 lines 14-62).

Regarding claim 49, Vataja's method for delivery of advertisement information to mobile units teaches obtaining a message provided by the sender (Sponsor/User) (Sections 0025-0028); obtaining a location designated by the sender for delivery of the message (Sections 0004-0006 and 0027); tracking a specified mobile object having a position-determining device that determines its own current position, and which transmits its then current position at preset time intervals (Sections 0029-0031); determining from the transmitted current position whether the specified mobile object

has reached the designated location (Sections 0029-0031); and initiating a procedure for automatic delivery of the message electronically to the intended recipient upon the specified mobile object being determined to have reached the designated location (Sections 0008 and 0031), wherein the message is at least one of data, text, audio and video modes (SMS, picture; Sections 0025, 0027, and 0034). Vataja fails to teach wherein a mode in which the message is reproduced for the intended recipient is in accordance with a setting controlled by the intended recipient.

Owensby's method for providing targeted messages based on wireless mobile location teaches a mode in which the message is reproduced for the intended recipient is in accordance with a setting controlled by the intended recipient (Col. 9 line 50-Col. 10 line 11).

5. Claims 14-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vataja (US Pat Pub# 2002/0123327) in view of Teshima (US Pat Appl# 2002/0032035).

Regarding claim 14, Vataja's location- based message teaches the limitations in claim 1. Vataja fails to teach retrieving a message from among a plurality of stored messages.

Teshima teaches wherein the obtaining of the message comprises retrieving a message from among a plurality of stored messages based on input from the sender (Sections 0015 and 0047-0051).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate retrieving a

message from among a plurality of stored messages as taught by Teshima into Vataja's location-based message in order to increase revenue (Sections 0005-0006).

Regarding claim 15, the combination including Teshima teaches wherein the obtaining of the designated location comprises obtaining a location based on input from the sender (Sections 0015 and 0047-0051).

Regarding claim 16, the combination including Teshima teaches wherein the obtaining of the designated location comprises retrieving a location from among a plurality of stored locations based on input from the sender (Sections 0100-0101).

Regarding claim 18, the combination including Teshima teaches wherein the rule includes instructions for repeating delivery of the message (Section 0137).

6. Claims 28-29 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vataja (US Pat Pub# 2002/0123327) in view of Kohar et al. (US Pat# 6,987,976).

Regarding claim 28, Vataja teaches obtaining a message based on input from the sender (Sections 0027-0028); obtaining a designated location based on input from the sender (Sections 0004-0006 and 0027); obtaining identification of at least two recipients, from among the plurality of potential recipients, specified based on input from the sender as intended recipients of the message (Sections 0025 and 0031-0032); and automatically delivering the message electronically to one of the intended recipients based upon the position of the one of the intended recipients relative to another of the intended recipients, as derived from the position-determining technology

(Sections 0008 and 0029-0032). Vataja fails to teach determining a position of one of the intended recipients relative to another recipient.

Kohar teaches determining position of the one of the intended recipients relative to another of the intended recipients, as derived from the position-determining technology (Col. 2 lines 42-56).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate determining a position of one of the intended recipients relative to another recipient as taught by Kohar into Vataja's location-based message in order to provide a more useful method of providing position information (Col. 1 lines 19-21).

Regarding claim 29, the combination including Vataja teaches wherein each of the plurality of potential recipients includes a position-determining device to determine its current position (Sections 0004-0008 and 0027-0032).

Regarding claim 30, Vataja teaches obtaining, at the server, a message based on input from a first client (Sections 0027-0028); obtaining, at the server, an identification of a second, mobile client as the intended recipient for receiving the message, based on input from the first client (Sections 0004-0006, 0027-0028, and 0031-0032); obtaining, at the server, an identification of a third client, based on input from the first client (Sections 0025 and 0031-0032); and automatically triggering electronic delivery of the message to the intended recipient upon the second, mobile client being determined to be at a designated position (Sections 0008 and 0029-0032).

Vataja fails to teach determining a position of one of the intended recipients relative to another recipient.

Kohar teaches determining position of the one of the intended recipients relative to another of the intended recipients, as derived from the position-determining technology (Col. 2 lines 42-56).

Regarding claim 31, Kohar teaches wherein the third client is also a mobile client having a position-determining device (Col. 2 lines 42-56).

Regarding claim 32, Vataja teaches wherein the first and second clients are the same client (Sections 0004-0008 and 0027-0032).

Regarding claim 45, Vataja teaches means for obtaining a message based on input from the sender (Sections 0025-0028); means for obtaining a designated location based on input from the sender (Sections 0004-0006 and 0027); means for obtaining identification of at least two recipients, from among the plurality of potential recipients, based on input from the sender (Sections 0004-0006, 0027-0028, and 0031-0032); and means for automatically delivering the message electronically to one of the identified recipients (Sections 0008 and 0029-0032). Vataja fails to teach determining a position of one of the intended recipients relative to another recipient.

Kohar teaches determining position of the one of the intended recipients relative to another of the intended recipients, as derived from the position-determining technology (Col. 2 lines 42-56).

Regarding claim 46, Vataja teaches means for obtaining, at the server, a message based on input from a first client (Sections 0025-0028); means for obtaining,

at the server, an identification of a second, mobile client as the intended recipient for receiving the message, based on input from the first client (Sections 0004-0006, 0027-0028, and 0031-0032); means for obtaining, at the server, an identification of a third client, based on input from the first client (Sections 0004-0006, 0027-0028, and 0031-0032); and means for automatically triggering electronic delivery of the message to the intended recipient upon the second, mobile client (Sections 0008 and 0029-0032). Vataja fails to teach determining a position of one of the intended recipients relative to another recipient.

Kohar teaches determining position of the one of the intended recipients relative to another of the intended recipients, as derived from the position-determining technology (Col. 2 lines 42-56).

Response to Arguments

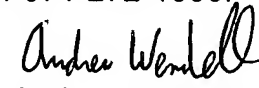
7. Applicant's arguments with respect to claims 1-6, 9-25, 28-42, and 45-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Wendell whose telephone number is 571-272-0557. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Andrew Wendell
Examiner
Art Unit 2618

4/20/2007


NAY MAUNG
SUPERVISORY PATENT EXAMINER